

Applicants: Peter S. Linsley et al.
U.S. Serial No.: 08/219,200
Filed: March 29, 1994
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Amendments to the Specification:

In item 6 of the Notice of Allowability, the Examiner is requesting that Applicants amend the Brief Description of the Figures in accordance with the changes made to the formal drawings. In response, Applicants submit amendments to the specification that reflect the changes made to the formal drawings.

Support for the changes can be found in the originally-filed application at page 9, lines 21-35. The amendment to the Brief description of Figures 7, 8 and 9 do not involve new matter. Entry of these amendments is requested.

In accordance with 37 C.F.R. §1.121(b)(1)(iii), attached hereto as Exhibit 1, is a marked-up version of the changes made to the specification. Accordingly, entry of and consideration of the amendments to the subject application are respectfully requested.

The Oath/Declaration:

In item 7 of the Notice of Allowability, the Patent Office states that the oath or declaration is defective because it fails to comply with 37 C.F.R. §1.67(a). Applicants provide a new declaration in a separate, but concurrent, submission and Petition under 37 C.F.R. §1.47(a).

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Reasons for Allowance:

In the Notice of Allowability, dated August 13, 2002, issued by the Patent Office in connection with the subject application, the Patent Office asserts an interpretation of the term "B7" which differs from the interpretation stated in a decision by the Board of Appeals for the subject application (e.g., Appeal No. 1999-2330). Applicants respectively wish to address this matter herein.

The only issues on Appeal were: (1) whether the claimed methods were enabled (112, first paragraph rejection; see Appeal Decision at pages 4 and 6); and (2) whether in the claimed methods, B7 is definite and whether the use of B7 encompasses more than the use of B7-1 (112, first and second paragraph rejections; see Appeal Decision at pages 4 and 16).

With respect to the issue of definiteness, the Board of Appeals states that:

"The appellants have also countered the examiner's position, suggesting that the claim language is not indefinite as "applicants have provided the entire nucleotide sequence for one B7 protein and described the functions which other members of the class of proteins provided by the invention would have to have." Brief, page 18. The appellants argue that art searches in the field establish that "B7" is understood by those of ordinary skill in the art to be the protein having the characteristics of the protein as claimed. We agree.

Appellants argue that despite the fact that they do not disclose every known B7 molecule, the identification of other species in the class would not entail undue experimentation because applicants' disclosure outlines different assays for the identification of B7 molecules as claimed. See specification at pages 43, 61, and 66. Brief, pages 18-19. *We also agree that the specification has provided reasonable guidance to one of ordinary skill in the art to identify other species of B7 protein in the class without undue experimentation. The rejection of claims 79-94 under 35 U.S.C. §112, first and second paragraphs are reversed.*" (see Appeal Decision at page 18, first and second full paragraphs (emphasis added).)

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Despite the ruling of the Board of Appeals, the Patent Office places on the record a narrower construction of the Board's decision. Specifically, the Patent Office stated:

"Upon reconsideration of the Decision on Appeal (Paper No. 59), the pending claims are deemed allowable.

It is noted that the Board of Appeals has interpreted the term "B7" consistent with the prosecution history and specification pages 6 and 11 as that described in Freeman, 1989, which is now referred to in the art as B7-1" (see Notice of Allowability, item 5)

Respectfully, it is the Applicants' position that the Patent Office has misconstrued the Board's statement and taken it out of context from the record in the Appeal. Moreover, the Patent Office has not acknowledged that, in addition to the Board's decision that B7 is definite and not ambiguous, the Board also decided that the instantly claimed and allowed methods encompass the use of any B7.

The Board clearly rejected and reversed the Patent Office's finding that the specification of 08/219,200 does not describe or enable identification of other B7 antigens meeting the structural or functional limitations of the instant invention (see Appeal Decision at page 18, second full paragraph). As noted above, the Board ruled that the specification provided reasonable guidance to one of ordinary skill in the art to identify other species of B7 protein in the class without undue experimentation. For the Patent Office to disregard and misconstrue the holding by the Appeal Board is improper.

Accordingly, the present claims encompass methods for inhibiting T cell proliferation and methods for inhibiting the binding of Cd28 positive T cells to B7 positive B cells by using any soluble B7 molecule, in accord with the Board's Decision.

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CONCLUSION

Applicants respectfully contend that the foregoing amendments address the outstanding rejections stated in the Notice of Allowability. If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. If any fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,



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